

REMARKS

I. Introduction

Claims 1-23 are pending in the application. Claims 1, 9, 11, 13, 15, 17, 19, 21, and 23 are independent. All pending claims stand rejected. In particular, claims 1, 2, 5, and 9-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,026,375 (hereinafter "Hall"), claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hall, claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hall, in view of U.S. Patent No. 6,587,835 (hereinafter "Treyz"), and claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hall, in view of U.S. Patent No. 6,507,727 (hereinafter "Henrick").

Upon entry of this amendment, which is respectfully requested, claims 2-23 will be cancelled without prejudice or disclaimer, and claim 1 will be amended and new claim 24 will be added to advance prosecution. No new matter is believed added by this amendment. Support the amendment and for the newly presented claim exists in the specification and claims as originally filed, and all such matter has previously been searched by the Examiner.

Applicants respectfully request reconsideration and further examination of the pending claims in view of the arguments presented herein and in accordance with 37 CFR §§1.113, 1.116.

Applicants respectfully note that the present amendment places the currently presented claims in form for allowance or in better form for appeal.

A. 35 U.S.C. §102(e) Rejections

Amended claim 1 and claims 2, 5, and 9-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hall. At least because claims 5 and 9-23 are cancelled by this amendment, the rejection of these claims is moot. With respect to amended claim 1 (which now generally includes the limitations of cancelled claim 2), applicants respectfully traverse this ground for rejection as follows.

a) Hall fails to teach or suggest receiving a customer's past transaction history from a customer database on a customer's device

Applicants respectfully assert that Hall fails teach or suggest embodiments as described in amended claim 1 (and new claim 24). For example, Hall fails to teach or suggest *receiving a customer's past transaction history from a customer database on a customer's device* (a feature generally recited in each of the above-identified claims).

The Examiner states that "Hall et al teach [sic] a process including...*a customer database 374 on the customer communication device*". (Paper No. 10, pg. 2; emphasis added). Applicants respectfully note that the customer database (reference no. 374) of Hall is clearly shown and described as being resident with the "Service Provider", reference no. 150. (See, Hall Fig. 3). Nowhere in Hall is it taught or suggested that the customer database reside on the customer's device. Accordingly, Hall does not teach or suggest receiving any information from a customer database on the customer's device, much less receiving a past transaction history.

Thus, Applicants respectfully assert that Hall fails to anticipate embodiments as recited in amended claim 1 (and new claim 24) at least because Hall fails to teach or suggest *receiving a customer's past transaction history from a customer database on a customer's device*. Accordingly, Applicants respectfully request that the §102(e) rejection of amended claim 1 be withdrawn, and that each of the currently presented claims be allowed.

b) Hall fails to teach or suggest an insitu customer device

Applicants respectfully assert that Hall fails teach or suggest embodiments as described in amended claim 1. For example, Hall fails to teach or suggest *an insitu customer device* (a feature generally recited in amended claim 1).

First, Applicants respectfully note that the "insitu" limitation (originally presented in claims 15-22) has not been addressed by the Examiner. Further, Applicants respectfully note that Hall fails to teach or suggest such a limitation. For example, Hall is directed to taking remote orders from consumers and having the product ready by the time the consumer arrives at the pickup location. (Abstract). Nowhere does Hall describe a customer placing an order "insitu" (e.g., at the merchant's location). Insitu ordering would negate the necessity of Hall entirely (e.g., the consumer is already at the merchant's location, thus the methods in Hall for estimating how

long it will take the consumer to reach the merchant's location, etc., would be unnecessary).

Accordingly, Applicants respectfully assert that Hall fails to anticipate embodiments as recited in amended claim 1 at least because Hall fails to teach or suggest *an insitu customer device*. Accordingly, Applicants respectfully request that the §102(e) rejection of amended claim 1 be withdrawn.

c) Hall fails to teach or suggest a local merchant order device in communication with a customer's device

Applicants respectfully assert that Hall fails teach or suggest embodiments as described in new claim 24. For example, Hall fails to teach or suggest *a local merchant order device in communication with a customer's device* (a feature generally recited in new claim 24).

For example, Hall describes a customer device (reference no. 105) being in communication with a "Service Provider's System" (reference no. 150), and the provider's system being in communication with "Local Facilities" (reference nos. 172-176). (See, Hall Fig. 1). Accordingly, in the Hall system, a customer may not place an order directly with a local merchant. In contrast, new claim 24 describes a "local" merchant device being in communication with the customer's device. In new claim 24, for example, the "local" merchant device and the customer's device may communicate using short-range protocols, such as Bluetooth™. In Hall however, because the provider's system is centrally located, Bluetooth™ would not enable the provider's server to communicate with the customer's device (*i.e.*, the distance would be too far).

At least for this reason, Applicants respectfully request that new claim 24 be allowed.

B. 35 U.S.C. §103(a) Rejections

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hall, claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hall, in view of Treyz, and claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hall, in view of Henrick. At least because claims 3-4, 6-7, and 8 are cancelled by this amendment, the rejection of these claims is moot.

Patent

Reply Under 37 C.F.R. §1.116

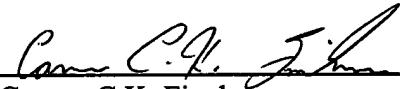
Patent App. Ser. No. 09/740,941
IBM Docket No. YOR9-2000-0277 (1963-4982)

II. Conclusion

Applicants therefore respectfully assert that each of the currently presented claims is patentable over the cited reference. Applicants' silence with respect to other comments made in the Office Action does not imply agreement with those comments. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at 203-972-4982.

Respectfully submitted,

April 2, 2004
Date



Carson C.K. Fincham
Registration No. 54,096
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-4982